

REMARKS

By this Office Action, the Examiner has required restriction to one of the following groups of Claims under 35 U.S.C. § 121:

Group I: Claims 1-22 and 25, drawn to a hybrid promoter, nucleic acids and vectors comprising the promoter and a cell modified by exposure to the promoter, classified in class 536, subclass 23.1; class 435, subclass 325; and

Group II: Claims 23-24, drawn to methods of using a vector to prepare a composition intended for inducing the expression of a gene in an inflammatory cell or chondrocyte, classified in class 435, subclass 91.4

Although the Examiner has admitted that the subject matter of the Claims of Groups I and II are related as product and process of use, the Examiner has asserted that these the subject matter of each of these groups of Claims is distinct because either (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant matter, the Examiner believes the subject matter of these two groups of Claims is distinct from each other because the vectors of Group I can be used as probes for identifying a nucleic acid comprising a homolog of the gene of interest or for identifying a nucleic acid that comprises a promoter homologous to the PLA2s gene promoter of the Invention.

In response, solely to be responsive to the requirement for restriction, Applicants provisionally elect, WITH TRAVERSAL, to prosecute the subject matter of the Claims of Group I, Claims 1-22 and 25, drawn to a hybrid promoter, nucleic acids and vectors comprising the promoter and a cell modified by exposure to the promoter, classified in class 536, subclass 23.1; class 435, subclass 325. Furthermore, Applicants respectfully request reconsideration of the requirement for restriction for reasons provided as follows:

MPEP § 803 clearly states that restriction is *not required* unless one of the following reasons appear:

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Moreover, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups of Claims designated by the Examiner fail to define "inventions" with properties so distinct as to warrant separate examination and search.

For example, Claims 1-22 and 25 are drawn to a hybrid promoter, nucleic acids and vectors comprising the promoter, and a cell modified by exposure to the promoter. The Examiner has classified the subject matter of these Claims in class 435. However, the Examiner has also classified the subject matter of the Claims of Group II, i.e., Claims 23-24, drawn to methods of using a vector to prepare a composition intended for inducing expression of a gene in an

inflammatory cell or chondrocyte, in class 435. Thus, a search of the subject matter of the Claims of Group II requires an additional search of the **identical** class searched with respect to the subject matter of the Claims of Group I. Indeed, the Examiner has *admitted* that the subject matter of the Claims of Group I is related to the subject matter of the Claims of Group II. Hence, Applicants respectfully submit that the search and examination of the entire Application can be made without a serious burden to the Examiner.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit the conjoint examination and inclusion of all the Claims of the present Application would not present an undue burden on the Examiner. Accordingly, withdrawal of the Requirement for Restriction is respectfully requested.

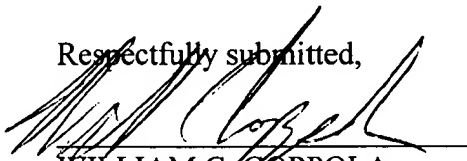
Fees

No additional fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 18-1982 for any underpayment, or credit any overages.

CONCLUSION

In view of the above, early action on the merits is courteously solicited.

Respectfully submitted,


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